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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/820,441	03/28/2001	Thomas H. Campbell	21120-303	6655

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 10/21/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,441

Applicant(s)

CAMPBELL ET AL.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner acknowledges the cancellation of claims 2, 4 and 6-24 via the Preliminary Amendment filed March 28, 2001. Claims 1, 3 and 5 are pending.

Information Disclosure Statement

2. The information disclosure statement filed March 15, 2002 has not been fully considered because it fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The Non-Patent Literature Documents cited in the IDS of March 15, 2002 are not present in the application file. The IDS has been placed in the application file, but the Non-Patent Literature Documents referred to therein have not been considered.

Specification

3. The disclosure is objected to because of the following informalities: In page 1, lines 17-18, the current status of the related U.S. patent application should be provided. Appropriate correction is required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. Claim 1 is objected to because of the following informalities:

- a. In line 1, "suitable" apparently should be deleted.
- b. In line 3, "suitable" apparently should read --adapted-- or --configured--.
- c. In line 5, "suitable" apparently should be deleted.
- d. In line 8, "suitable" apparently should be deleted.

Appropriate correction is requested.

6. Claim 3 is objected to because of the following informalities:

- a. In line 3, "suitable" apparently should read --adapted-- or --configured--.
- b. In line 5, "suitable" apparently should be deleted.
- c. In line 7, "suitable" apparently should be deleted.

Appropriate correction is requested.

7. Claim 5 is objected to because of the following informalities:

- a. In line 3, "suitable" apparently should read --adapted-- or --configured--.
- b. In line 5, "suitable" apparently should be deleted.
- c. In line 9, "suitable" apparently should be deleted.
- d. In line 10, "suitable" apparently should be deleted.

Appropriate correction is requested.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Inconsistent terminology used to define a claim limitation renders the claim indefinite. Specifically, the limitation "the infusion port being positioned between..." at line 11 renders the claim indefinite. It is unclear whether the tool has only one infusion port as the limitation at line 11 implies, or if there can be more infusion ports as indicated by the limitation "at least one infusion port" at line 10 of the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Nichols et al. ('708).

Nichols et al. teach a combined thermal mapping and agent delivery tool. The tool includes an

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elongated member **10** for insertion into a body vessel; a plurality of thermal sensors **61** suitable for detecting the temperature of a wall of the vessel; and at least one infusion port **42** is provided for delivering an agent into the vessel (see Fig. 9).

12. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Tachibana et al. ('842). Tachibana et al. teach an interventional combined thermal mapping and agent delivery tool. The tool **10** includes an elongated member for insertion into a body vessel. An expansion device **12,30** is carried by the elongated member. A multiplicity of thermal sensors **22** suitable for detecting the temperature of a wall of the vessel are disposed on the expansion device. An outer sheath or coating may be positioned over the thermal sensors. At least one infusion port **26,26A** is provided for delivering an agent into the vessel in the region of the thermal sensors.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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14. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 5,924,997. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the instant application is merely broader than the claim of the patent. Claim 18 of the patent recites a thermal mapping catheter having an elongated member for insertion into a body vessel, a plurality of thermal sensors, a plurality of infusion ports for delivering agents, and several other elements. The catheter of the patent claim is a type of "tool" as claimed in claim 3 of the instant application. Since the narrower claim of the patent "anticipates" the broader claim of the instant application, the claims are not patentably distinct.

15. Claims 1, 3 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 5 of U.S. Patent No. 6,245,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broader than the claims of the patent. Regarding claim 1 of the application, claim 1 of the patent recites an elongated member, a plurality of thermal sensors, an expansion device and a sheath/member covering the thermal sensors, as well as additional limitations not claimed in claim 1 of the application. Regarding claim 3 of the application, claim 3 of the patent recites an elongated member, a plurality of thermal sensors, and at least one infusion port, as well as additional limitations not claimed in claim 3 of the application. Regarding claim 5 of the application, claim 5 of the patent recites an elongated member, a plurality of longitudinally spaced thermal sensors, an expansion device and at least one infusion port positioned between selected thermal sensors, as well as additional

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limitations not claimed in claim 5 of the application. Since the narrower claims of the patent "anticipates" the broader claims of the instant application, the claims are not patentably distinct.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on (703) 308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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July 26, 2004